



PATENT  
Attorney Docket 498.02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Jacoby M. Thwaites

Serial No. 9 08/925,896

Filed: August 9, 2001

For: **INFORMATION ROUTING**

) Group Art Unit: 2151

) Examiner: unknown

) **PETITION TO CORRECT INVENTORSHIP**

) **PURSUANT TO 37 CFR §1.48(a)**

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Commissioner for Patents  
Washington, D.C. 20231

**CERTIFICATE OF MAILING**

I hereby certify that the correspondence enclosed herein is being deposited as first class mail with the United States Postal Service on this date 11/16/2001, in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

By: Caroline Pfahl

Caroline Pfahl

Sir:

Applicant hereby petitions pursuant to 37 CFR § 1.48(a) to correct the inventorship of the above-identified application to identify Bimal Patel as a joint inventor. The error in inventorship occurred without any deceptive intent on the part of the inventors.

Included with this petition are: (1) the verified statement of Bimal Patel, the omitted inventor (Exhibit 1); (2) a new declaration by the joint inventors in accord with 37 CFR § 1.63 (Exhibit 2); (3) the written consent of assignee in accord with 37 CFR § 3.73(b) (Exhibit 3); and (4) the fee set forth in 37 CFR § 1.17(i).

I. Statement of Facts

Applicant first filed a patent application for the present subject matter on August 9, 2000 in the United Kingdom (App. No. 0019625.3). A certified copy of the U.K. patent application is being submitted under separate cover concurrently with this petition. The U.K. patent application was prepared on the instructions of Mr. Jacoby Thwaites, who was identified as an

inventor, and the application was filed in the name of Michaelhouse Management Ltd., assignee of the present application, being the company for which Mr. Thwaites and Mr. Patel both work.

Prior to the one year anniversary date of the U.K. patent application, applicant (through its U.K. patent counsel) retained U.S. patent counsel to advise and assist applicant with the preparation and filing a U.S. counterpart to the U.K. application. During the end of July and beginning of August 2001, Mr. Thwaites reviewed and finally approved a patent specification which substantially incorporated the original U.K. application, but which presented claims of somewhat differing scope and in a different format than those of the original U.K. application. Mr. Thwaites was initially identified as the sole inventor, and after review of the application, he executed a declaration and an assignment of the invention on August 6, 2001. The application was timely filed on the one-year convention deadline date so as to preserve the priority claim to the original U.K. application.

However, because the scope of the claims filed in the U.S. application differed from those in the original U.K. application, and upon notice that under U.S. law (in contrast to U.K. law), the identified inventors, rather than their corporate employer, would have first right to a claimed invention, Mr. Thwaites thereafter reconsidered the question of inventorship and provided a copy of the U.S. patent application as filed to Mr. Patel, an employee of the assignee who had assisted Mr. Thwaites during the course of developing and refining the present invention. Upon review, Mr. Patel and Mr. Thwaites both realized that Mr. Patel made inventive contributions to aspects of development as represented in all the claims. The failure to name Mr. Patel as an inventor was an error which arose without deceptive intent on the part of either Mr. Thwaites or Mr. Patel, as neither appreciated that it might affect their corporate employer's rights (as assignee) to the claimed invention developed in the course of their employment, and this petition has been filed promptly on behalf of applicant upon discovering the true facts regarding inventorship.

## II. Argument

37 CFR § 1.48(a) authorizes a petition to the Commissioner to correct inventorship in a patent application. The omission of Bimal Patel as a named inventor in this application occurred

without deceptive intent. Applicants have upon review of the U.S. application as filed determined that Messrs. Thwaites and Patel are co-inventors of certain subject matter of the present application. In accordance with 37 CFR § 1.48(a)(1), we are attaching a declaration from Mr. XX declaring that the claims prepared and filed by U.S. patent counsel include subject matter which was invented by him, and that the error in inventorship occurred without deceptive intention on his part. (Exhibit 1).

We have also attached a supplemental declaration of the joint inventors as required by 37 CFR § 1.63 (Exhibit 2), and the written consent of the assignee (Exhibit 3).

Based on this timely filed request, the application should be amended to recite the correct inventorship as described herein.

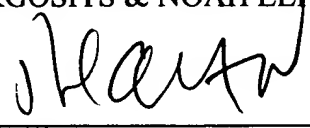
III. Conclusion

For all of the foregoing reasons, applicant respectfully requests that this petition to correct inventorship be granted by amending the subject application to add XX as a joint inventor.

Respectfully submitted,

DERGOSITS & NOAH LLP

Dated: 11/14/01

By:   
Richard A. Nebb  
Reg. No. 33,540

Please send all correspondence to:

Dergosits & Noah LLP  
Four Embarcadero Center, Suite 1150  
San Francisco, California 94111  
(415) 705-6377

Please refer to Attorney Docket No. 498.02

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Patent  
Attorney Docket No: 498.02

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Jacoby M. Thwaites

Serial No. 08/925,896

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Assistant Commissioner for Patents  
Washington, D.C. 20231

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Group Art Unit: 2151

Examiner: unknown

STATEMENT OF INVENTOR BIMAL  
PATEL PURSUANT TO 37 CFR § 1.48(a)

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By:

CAROLINE PRAHL

Sir:

Inventor Bimal Patel hereby states the following, in support of the Petition to Correct Inventorship filed concurrently herewith in the present matter:

1. I am employed as a Director of Michaelhouse Management Ltd. ("MML").
2. During the course of my employment by MML, I worked with my colleague, Jacoby M. Thwaites, to develop certain subject matter related to information routing that is disclosed in the above-identified patent application. Specifically, I contributed jointly to the development of the invention as claimed.
3. During August of 2001, I was provided with a copy of the subject patent application as filed in the U.S. My review of the patent application revealed that the patent claims all include subject matter for which I have contributed as a co-inventor. Therefore, an amendment to add me as a joint inventor is necessitated by the filing of these claims.
5. It is my understanding that I was not listed as an inventor of the above-referenced patent application. Because the scope of the claims as filed in the U.S. differs significantly from the claims as filed in the U.K., and the differences between UK and U.S. law regarding

ownership of an invention only came to our attention after the filing of the U.S. application, the omission of my name as an inventor occurred without any deceptive intent on my part.

6. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: 13 - Nov - 01 2001

By: B. Patel  
Bimal Patel



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Attorney Docket 498.02

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Jacoby M. Thwaites

Serial No. 08/925,896

Filed: August 9, 2001

For: INFORMATION ROUTING

) Group Art Unit: 2151

) Examiner: unknown

) **CONSENT OF ASSIGNEE**  
) **PURSUANT TO 37 CFR § 3.73(b)**

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Washington, D.C. 20231

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By:	<u>Carolene Pfaff</u> CAROLINE E. PFAFF

Sir:

The undersigned hereby declares as follows:

1. I am authorized to act on behalf of Michaelhouse Management Ltd.
2. Michaelhouse Management Ltd., 21 Worship Street, London EC2A 2BH, United Kingdom, hereby certifies that it is the assignee of the entire right, title, and interest in the patent application identified above by virtue of an assignment from the inventor. The assignment is recorded in the U.S. Patent & Trademark Office at Reel 012072 and Frame 0405. The undersigned has reviewed all the documents in the chain of title for the patent application identified above, and, to the best of the undersigned's knowledge and belief, title is in the assignee Michaelhouse Management Ltd.
3. Michaelhouse Management Ltd. hereby consents to the correction of inventorship to name Jacoby M. Thwaites and Bimal Patel as joint inventors of the subject filing of U.S. Patent App. No. 09/925,896.
4. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that

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these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 USC § 1001 and that such willful false statements may jeopardize the validity of the application, any patent issued thereon, or any patent to which this declaration is directed.



\_\_\_\_\_  
Jacoby M. Thwaites, Director  
Michaelhouse Management Ltd.

9 Nov 01

\_\_\_\_\_  
Date

Please send all correspondence to:

Richard A. Nebb  
Dergosits & Noah LLP  
Four Embarcadero Center, Suite 1150  
San Francisco, California 94111  
(415) 705-6377

Please refer to Attorney Docket No. 498.02

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